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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/757,940  | 01/15/2004  | Stephen G. Moore     | 14846-25            | 4644             |
| <div>7590 07/02/2008<br/>MICHAEL B. JOHANNESSEN, ESQ.<br/>LOWENSTEIN SANDLER PC<br/>65 LIVINGSTON AVENUE<br/>ROSELAND, NJ 07068</div> |             |                      |                     |                  |
| EXAMINER  |             |                      |                     |                  |
| FERTIG, BRIAN E   |             |                      |                     |                  |
| ART UNIT  |             | PAPER NUMBER         |                     |                  |
| 3694  |             |                      |                     |                  |
| MAIL DATE   |             | DELIVERY MODE        |                     |                  |
| 07/02/2008  |             | PAPER                |                     |                  |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/757,940

**Applicant(s)**

MOORE ET AL.

**Examiner**

BRIAN FERTIG

**Art Unit**

3694

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 26 March 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SF/ICE)  
Paper No(s)/Mail Date 2/25/2008
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

This action is in response to Applicant's filing of 3/26/2008. Independent claims 1 and 7 have been amended. Claims 1-15 are pending and examined below.

#### ***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

3. Claims 1, 4-7, and 12-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 5,787,402 to Potter (Potter).

#### With respect to claim 1

Potter teaches:

A method for pricing a trade comprising:

providing a user input for entering trade data (inputting information, see col 3, line 22);

providing a structure for receiving said trade data (new order entry screen, see col 13, lines 34-43 and Fig 24);

providing a user input for optionally manually entering pricing data (see col 5, lines 15-21 in combination with col 2, lines 17-34, note that teaching contemplates a combination of automatic and manual orders and specifically teaches manually determining price data as the method of the prior art. The combination of these teaching, therefore fairly suggests an input for manually entering pricing data. Note further that the 'for' clause is a statement of intended use. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. The disclosure of a combination of automatic and manual orders suggest that it is capable.);

if pricing data has been manually entered by the user, adding the pricing data to the structure (see col 5, lines 15-21 in combination with col 2, lines 17-34, note that the teaching contemplates a combination of automatic and manual orders and specifically teaches manually determining price data as the method of the prior art. The combined teaching fairly suggests that a manually entered order would be added to

the pricing structure as a natural processing progression in a system with combined manual and automatic features);

if the user has not manually entered pricing data, transmitting said structure to a pricing system (request a spot rate, see col 7, lines 44-52, note that this branch follows the automatic order suggested by col 5, lines 15-21);

if the user has not manually entered pricing data, receiving said structure from said pricing system (the FX Trade Server then relays the requested rate quotation to the client PC, see col 7, lines 53-67); and

displaying said structure with said trade data including pricing information (when the rate is received, the Term of the currency will be displayed, see col 8, lines 1-5).

It would have been obvious to one having ordinary skill in the art at the time of Applicant's invention to have combined the manual ordering features recited by Potter as being in the prior art with the automated features of Potter in order to accommodate automatic and manual orders as taught explicitly by Potter (see col 5, lines 15-21). While Potter discloses the disadvantage of manual processing as being labor intensive, Potter also contemplates his system as being capable of both automatic and manual order, suggesting that he acknowledges the advantages of bridging the gap between prior art and state of the art processing techniques.

With respect to claim 4

Potter teaches:

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A method in accordance with claim 1 (see rejection of claim 1 above) wherein providing a user input for entering one or more wades comprises translating data representing one or more trades from a user treasury system into a form suitable for use in said structure (inputting information, see col 3, line 22. Note that the input action translates the conceptual order, including the goals and aims of the purchaser, into the specific inputs to be processed by the system).

(see rationale supporting obviousness and motivation to combine of claim 1 above)

With respect to claim 5

Potter teaches:

A method in accordance with claim 1 (see rejection of claim 1 above) wherein displaying said structure comprises translating data from said structure into data representing one or more trades in a user treasury system (transaction view, see col 10, lines 51-60 and Fig 18).

(see rationale supporting obviousness and motivation to combine of claim 1 above)

With respect to claim 6

Potter teaches:

A method in accordance with claim 1 (see rejection of claim 1 above) wherein providing a user input for entering trade data comprises providing a user input for entering trade data directly into said structure (various terminals, see col 3, lines 20-26).

(see rationale supporting obviousness and motivation to combine of claim 1 above)

With respect to claim 7

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Potter teaches:

A method for pricing a trade comprising:

providing a user input for entering trade data into a structure at a user system (inputting information, see col 3, line 22);

providing a user input for optionally entering pricing data into the structure at the user system (see col 5, lines 15-21 in combination with col 2, lines 17-34, note that teaching contemplates a combination of automatic and manual orders and specifically teaches manually determining price data as the method of the prior art. The combination of these teaching, therefore fairly suggests an input for manually entering pricing data. Note further that the 'for' clause is a statement of intended use. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. The disclosure of a combination of automatic and manual orders suggest that it is capable.);

if pricing data has not been entered at the user system, transmitting said structure to a pricing system (request a spot rate, see col 7, lines 44-52, in combination with col 5, lines 15-21, note that this branch is following the automatic order suggested by Potter);

if the user has not manually entered pricing data, pricing said trade data at said pricing system (system then automatically generates an offer, see col 3, lines 26-31);

if the user has not manually entered pricing data, adding said pricing data to said structure at said pricing system (stores a time-stamped copy of the rate quotation, see col 7, lines 53-56);

if the user has not manually entered pricing data, transmitting said structure to said user system (relays the requested rate quotation to the client PC, see col 7, lines 53-67); and

displaying said trade data and said pricing data at said user system (the Term of the currency will be displayed by the client, see col 8, lines 1-5).

(see rationale supporting obviousness and motivation to combine of claim 1 above)

With respect to claim 12

Potter teaches:

A method in accordance with claim 7 (see rejection of claim 7 above) wherein providing a user input for entering trade data comprises translating data representing one or more trades from a user treasury system into a form suitable for use in said structure (inputting information, see col 3, lines 22. Note that the input action translates the conceptual order, including the goals and aims of the purchaser, into the specific inputs to be processed by the system).

(see rationale supporting obviousness and motivation to combine of claim 1 above)



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With respect to claim 13

Potter teaches:

A method in accordance with claim 7 (see rejection of claim 7 above) wherein displaying said structure comprises translating data from said structure into data representing one or more trades in a user treasury system (transaction view, see col 10, lines 51-60 and Fig 18).

(see rationale supporting obviousness and motivation to combine of claim 1 above)

With respect to claim 14

Potter teaches:

A method in accordance with claim 7 (see rejection of claim 7 above) further comprising: storing said trade data at said pricing system (stores a time-stamped copy of the rate quotation, see col 7, lines 53-56).

(see rationale supporting obviousness and motivation to combine of claim 1 above)

With respect to claim 15

Potter teaches:

A method in accordance with claim 14 (see rejection of claim 14 above) further comprising: executing one or more trades using said trade data stored at said pricing system (the FX Trade Server sends a copy of the trade to the Multibank Confirmation and Settlement System, see col 8, lines 19-67).

(see rationale supporting obviousness and motivation to combine of claim 1 above)

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4. Claims 2-3 and 8-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Potter in view of US Patent Application Publication 2002/0156719 to Finebaum (Finebaum).

With respect to claim 2

Potter teaches:

A method in accordance with claim 1 (see rejection of claim 1 above), but does not explicitly teach further comprising: encrypting said structure before transmitting said structure to a pricing system.

Finebaum teaches:

further comprising: encrypting said structure before transmitting said structure to a pricing system (see par 31 and 50).

It would have been obvious to one having ordinary skill in the art at the time of Applicant's invention to have provided Potter with the encryption features taught by Finebaum in order to have allowed only authorized users to access the system as taught explicitly by Finebaum (see par 31).

With respect to claim 3

Potter in view of Finebaum teaches:

A method in accordance with claim 1 (see rejection of claim 1 above) further comprising: decrypting said structure after receiving said structure from said pricing system (see Finebaum par 31 and 50, note that it is inherent in an encrypted communication system that the intended receiver of the communication decrypt it.)

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(see rational supporting obviousness and motivation to combine of claim 2 above).

With respect to claim 8

Potter in view of Finebaum teaches:

A method in accordance with claim 7 (see rejection of claim 7 above) further comprising: encrypting said structure at said user system before transmitting said structure to said pricing system (see Finebaum, par 31 and 50).

(see rational supporting obviousness and motivation to combine of claim 2 above).

With respect to claim 9

Potter in view of Finebaum teaches:

A method in accordance with claim 8 (see rejection of claim 8 above) further comprising: decrypting said structure at said pricing system after receiving said structure from said user system. (see Finebaum par 31 and 50, note that it is inherent in an encrypted communication system that the intended receiver of the communication decrypt it.)

(see rational supporting obviousness and motivation to combine of claim 2 above)

With respect to claim 10

Potter in view of Finebaum teaches:

A method in accordance with claim 7 (see rejection of claim 7 above) further comprising: encrypting said structure at said pricing system before transmitting said structure to said user system(see Finebaum, par 31 and 50).

(see rational supporting obviousness and motivation to combine of claim 2 above)..

With respect to claim 11

Potter in view of Finebaum teaches:

A method in accordance with claim 10 (see rejection of claim 10 above) further comprising: decrypting said structure at said user system after receiving said structure from said pricing system. (see Finebaum par 31 and 50, note that it is inherent in an encrypted communication system that the intended receiver of the communication decrypt it.)

(see rational supporting obviousness and motivation to combine of claim 2 above)

### ***Response to Arguments***

5. Applicant's arguments filed 3/28/2008 have been fully considered but they are not persuasive.
6. With respect to Applicant's argument that Potter does not teach or suggest "providing a user input for optionally manually entering pricing data," in combination with the other recited features of independent claims 1 and 7 and that Finebaum fails to remedy this deficiency, Examiner respectfully disagrees. Potter teaches an invention that is capable of both automatic and manual orders (see col 5, lines 15-21). Potter also teaches that manual processing or order, including the manual pricing of orders (see col 2, lines 18-34). The combined teaching fairly suggests providing a user input for optionally entering pricing data in so far as Potter contemplates his system as being capable of both automatic and manual order, suggesting that he acknowledges the advantages of bridging the gap between prior art and state of the art processing techniques and allows for pricing order manually to accommodate the prior art practice.

Note further that the 'for' clause is a statement of intended use. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. The disclosure of a combination of automatic and manual orders suggest that Potter's invention is capable.

7. With respect to Applicant's argument that the dependent claims are allowable for their incorporation of subject matter claimed in the independent claims, Examiner disagrees in light of the discussion above.

### ***Conclusion***

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

9. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to BRIAN FERTIG whose telephone number is (571)270-5131. The examiner can normally be reached on Monday - Friday 8:30am to 5:00pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on (571) 272-6712. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

11. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/B.F./

/Mary Cheung/

Primary Examiner, Art Unit 3694